

Attorney Docket No.: KUZ-0024
Inventors: ITO et al.
Serial No.: 10/531,433
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REMARKS

Claims 1-20 are pending in the instant application. Claims 18-20 were added in the amendment filed by Applicants on July 2, 2008. Accordingly, correction of Form PTOL-326, which indicates only claims 1-17 to be pending, is respectfully requested.

Claims 1-17 have been rejected. Claim 1 has been amended. Dependent claims 4, 8, 9, 12 and 15 and 18-20 have been canceled herein without prejudice in light of the amendments to claim 1. No new matter is added by these amendments.

Reconsideration is respectfully requested in light of these amendments and the following remarks.

Rejection under 35 U.S.C. § 103

The Examiner has maintained the rejection of claims 1-17 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,814,032 issued to Hori et al. ("Hori").

Applicants respectfully traverse this rejection.

It is unclear from the Office Action mailed October 15, 2008 whether or not patentability of claims 18-20 was considered. These dependent claims specified the content of polyisobutylene to be 85.0 to 93.0% by mass and the content of mineral oil to be 0.1 to 0.05 parts by mass based on

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polyisobutylene. In an earnest effort to advance the prosecution of this case, claim 1 has been amended to recite the content of polyisobutylene is 85.0 to 93.0% by mass and the content of the mineral oil liquid paraffin is 0.1 to 0.05 parts by mass based on polyisobutylene. Claims 18-20 have been canceled in light of this amendment.

In contrast, Hori's Examples 1-14 which are shown to exhibit low skin irritation each contain no more than 70% elastomer. Comparative Examples 1-5 of Hori, which contain more than 70% elastomer, each exhibit unfavorable results as for skin irritation. See Table 2 of Hori. Thus, while Hori might provide for amounts of elastomer at 70 parts by weight, it certainly teaches away from using any particular tape that uses more than 70 parts by weight elastomer as claimed in the instant application. In fact, teachings of Hori would actually have led the skilled person away from combining 85-93% of any elastomer in any tape, let alone one specifically including PIB, as claimed.

Further, claim 1 has been amended to recite liquid paraffin.

Nowhere does Hori disclose a particular tape having a mineral oil such as paraffin. Instead, out of the at least 36-member aliphatic hydrocarbon subset of Hori's at least 80 member list of potential absorption accelerators, Hori

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prefers 6 bromine- or chlorine-substituted aliphatic hydrocarbons, which would have tended to exclude liquid paraffin from serious consideration by one skilled in the art. Hori reinforces this exclusion by failing to indicate any preferred examples from within the other five absorption accelerator subsets, further reducing the attractiveness of paraffin as seen within the context of the at least 80 possible disclosed accelerators. Hori in effect creates at least three classes of accelerators, (1) those that are preferable with a subclass, (2) those that are not preferable within a subclass, and (3) those that are neutral. In the mind of one having skill in the art and without benefit of hindsight, Hori accordingly ranks paraffin not only after the at least 6 preferable hydrocarbons in its own subset, but also after the 44 other neutrally listed absorption accelerators.

The Examiner appeared to dismiss the above argument suggesting that the claims did not specify liquid paraffin. As discussed supra, the claims have been amended herein to now specify liquid paraffin.

Hori likewise fails to teach, suggest, or predict the recited proportion of liquid paraffin being from 0.1 to 0.05 parts by mass based on polyisobutylene as set forth in claim 1.

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Applicants respectfully disagree with the Examiner that ranges taught by Hori are close enough in proximity to those of the instant claims to reduce modifications to simply optimization of ranges through routine experimentation.

The facts herein are distinguishable from those outlined in MPEP 2144.05 and *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955), "[W]here the general conditions of a claim are disclosed in the prior art" and it was determined that it was "not inventive to discover the optimum or workable ranges by routine experimentation." In the instant rejection, the general conditions of claim 1 of a transdermal patch with the content of polyisobutylene being 85.0 to 93.0% by mass and the content of the mineral oil liquid paraffin being 0.1 to 0.05 parts by mass based on polyisobutylene are either not disclosed by Hori or taught to be undesirable by Hori.

Further, the specification shows unexpected superior properties and a criticality of the ranges as set forth in the instant claimed invention. Applicants respectfully direct the Examiner to Table 1 at page 19 as well as teachings at page 20 of the instant specification. There it is shown in Comparative Examples 1 and 3 that when the total content of PIB is 70% and the content of liquid paraffin is relatively large (28 or 24%, i.e., PIB:liquid paraffin=

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1:0.4 or 0.34), adhesive mass remains on the skin.

Comparative Example 2 shows that when the content of liquid paraffin is relatively small (1%, i.e. PIB:liquid paraffin = 1.0:0.014), insufficient adhesion is achieved. In contrast a transdermal patch as set forth in claim 1 wherein polyisobutylene ranges from 85.0 to 93.0% by mass and liquid paraffin was from 0.1 to 0.05 parts by mass based on polyisobutylene exhibited excellent adhesive properties, cohesive properties, adhesion properties and properties relating to remaining of adhesive mass to the skin. See Table 1 and page 20 of the instant specification.

Such superior properties are clearly not predictable from teachings of Hori. Evidence of the criticality of the claimed ranges and the superior properties achieved clearly rebuts any prima facie case of obviousness over Hori. See MPEP 2144.05 and 2145.

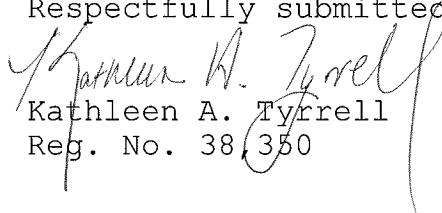
Withdrawal of this rejection under 35 U.S.C. 103(a) is respectfully requested.

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Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of all pending claims is earnestly solicited.

Respectfully submitted,


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